



# UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
Address: COMMISSIONER FOR PATENTS  
P.O. Box 1450  
Alexandria, Virginia 22313-1450  
[www.uspto.gov](http://www.uspto.gov)

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/711,217	11/09/2000	Martin Bergenwall	781.389USW1	6709
32294	7590	01/10/2005	EXAMINER	
SQUIRE, SANDERS & DEMPSEY L.L.P. 14TH FLOOR 8000 TOWERS CRESCENT TYSONS CORNER, VA 22182			PIZARRO, RICARDO M	
			ART UNIT	PAPER NUMBER
			2661	

DATE MAILED: 01/10/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	Application No.	Applicant(s)
	09/711,217	BERGENWALL ET AL.
	Examiner Ricardo Pizarro	Art Unit 2661

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

1) Responsive to communication(s) filed on 23 July 2004.

2a) This action is **FINAL**.                                   2b) This action is non-final.

3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

4) Claim(s) 1-37 is/are pending in the application.

4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.

5) Claim(s) 28-32 and 34-36 is/are allowed.

6) Claim(s) 1,11,12,17 and 21-27 is/are rejected.

7) Claim(s) 2-10,13-16 and 18-20 is/are objected to.

8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

9) The specification is objected to by the Examiner.

10) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a) All    b) Some \* c) None of:

- Certified copies of the priority documents have been received.
- Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
- Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

1) Notice of References Cited (PTO-892)                                   4) Interview Summary (PTO-413)  
2) Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   Paper No(s)/Mail Date. \_\_\_\_\_.  
3) Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_.

5) Notice of Informal Patent Application (PTO-152)  
6) Other: \_\_\_\_\_.

## FINAL ACTION

### ***Claim Objections***

Claim 37 is objected to because of the following informalities: In line 1 it is suggested to applicant to insert “ : “ after –comprising- for better reading of the claims.

### ***Claim Rejections - 35 USC § 102***

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) and the Intellectual Property and High Technology Technical Amendments Act of 2002 do not apply when the reference is a U.S. patent resulting directly or indirectly from an international application filed before November 29, 2000. Therefore, the prior art date of the reference is determined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

2. Claims 1, 11, 17 , 21, 22,23, 25 are rejected under 35 U.S.C. 102(e) as being anticipated by Widegreen.

US patent no. 6,374,112 ( Widegren) discloses a flexible radio access and resource allocation in a universal mobile telephone system disclosing a handover method between two radio systems with different physical traffic channels ( col 3 lines 55-58,

different radio channels Fig.7) and different radio link protocol comprising retransmission mechanism (RLP protocols, col 7 lines 21-22) , the method comprising handing over a non-transparent call from a radio channel from a traffic channel of an old radio system to a traffic channel of a new radio system ( col 7 lines 18-36), retaining the radio link protocol of the old radio system between a mobile station and an interworking function ( MS 30 in Fig. 3 and interworking function, col 8 lines 9-15), transmitting radio link frames of the old radio system adapted to the traffic channel of the new radio station.( by the IWF adapting GSM to UMTS and performing mapping, col 8 lines 9-14), as in claims 1,11,22, 23, 25; the new and old radio system are separate systems ( radio systems are different i.e. col 8 lines 51-54), as in claims 17, 21.

3. Claims 12, 24,26 , 27 are rejected under 35 U.S.C. 102(e) as being anticipated by Widegreen

A dual-mobile station ( MS 30 in Fig. 3) with capacity to operate between two radio systems ( col 3 lines 55-58, different radio channels Fig.7)with different physical traffic channels and different radio link protocols (RLP protocol, col 7 lines 21-22) comprising adapter means for establishing a first radio link protocol in a non-transparent call between the MS and an interworking function ( interface mapping col 8 lines 9-15), first radio system and second radio link protocol between the mobile station and the interworking function in a second radio system (RLP protocols, col 7 lines 21-22), means for performing a handover for the non-transparent call from a traffic channel of the first radio system to a traffic channel of the second radio system and viceversa ( col 7 lines 18-36), the system characterized in that said adapter is arranged to retain radio

link protocol of an old radio system between the mobile station and the interworking function in a handover that is carried out from the traffic channels of the first radio system to the traffic channel of the second radio system or viceversa ( MS 30 in Fig. 3 and interworking function, col 8 lines 9-15), said adapter means is arranged to transmit the radio link protocol frames of the old radio system adapted to the traffic channel of the new radio system .( by the IWF adapting GSM to UMTS and performing mapping, col 8 lines 9-14), as in claim 12, 24, 26, 27.

*Allowable Subject Matter*

4. Claims 28-31, 33-36 are allowed.

Claims 2-10,13-16 and 18-20 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claim. Please also notice objection to claim 37 under 37 CFR 1.75

*Conclusion*

5. Applicant's arguments filed 7/23/04 have been fully considered but they are not persuasive. Applicant indicates that the Widegreen '112 reference can not be used since its provisional application does not fully support the Widegreen reference ,therefore priority date of Widegreen is not a valid priority date for the current application

Examiner disagrees since both applications, Widegreen and its provisional , disclose related subjects such as Radio Access networks and the like, therefore its provisional application fully supports the Widegreen reference. Although Examiner cited column 7 lines 17-40 in Widegreen , those citations were broadly related to the radio access network discloses by Widegreen, not the UTRAN per se. Further in response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., UTRAN) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

**6. THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

**7. Any response to this final action should be mailed to:**

**Box AF**

Commissioner of Patents and Trademarks  
Washington, D.C. 20231

**or faxed to:**

(703) 872-93106

(for formal communications; please mark "EXPEDITED PROCEDURE", for  
informal or draft communications, please label "PROPOSED" or "DRAFT" )

Hand-delivered responses should be brought to 22- 20<sup>th</sup> Street S, Crystal  
Plaza Two, Lobby, Room 1B03, Arlington , VA 22202 ( Customer window).

Any inquiry concerning this communication or earlier communications from the  
examiner should be directed to **Ricardo Pizarro** whose telephone number is **(571) 272-  
3077**. The examiner can normally be reached on Monday-Thursday from 9:00 AM to  
5:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the  
examiner's supervisor, **Kenneth Vanderpuye** on (571) 272-3078.

12/20/2004

*Ricardo M. Pizarro*



KENNETH VANDERPUYE  
PRIMARY EXAMINER